

REMARKS

Claims 17-22 and 35 (previously misnumbered 23) stand rejected. Claims 17-22 and 35 remain pending in the application.

Claim Objection: Claim 23 is objected to as misnumbered, and has been renumbered as Claim 35 per the Examiner's objection.

102 Rejection:

Claims 17-19 and 35 are rejected as anticipated. This rejection is improper for the following reasons.

Claim 17 recites, in part:

actuating a first mechanism associated with the instrument to move the distal end portion of the inner member distally, relative to the outer hollow cannula, so that the distal end portion expands radially and engages a tissue sample to be extracted; and

actuating a second mechanism associated with the instrument to move the outer hollow cannula distally, relative to the distal end portion, to radially retract the distal end portion.

It is respectfully urged that Silverman 2,198,319 does not disclose or suggest either a first mechanism or a second mechanism. The Examiner cites col 2, lines 6-9 of Silverman as reciting a first mechanism associated with an instrument to move the distal end portion of the inner member distally. However, it is respectfully urged that Silverman teaches at column 2 that a needle 10 is plunged into the tissue, and that the next step is insertion of the interior needle in the manner shown in Figure 1. It is respectfully urged that Silverman does not teach a mechanism for moving the distal end of an inner member distally relative to the outer hollow cannula, but instead merely states an internal needle is inserted in the outer needle, presumably by hand. Accordingly, the Examiner is respectfully requested to point out where the steps of actuating first and second mechanisms are shown in Silverman, or withdraw the rejection.

Likewise, Claim 35 recites, in part:

providing an instrument comprising, and at least one mechanism for moving the outer hollow cannula relative to the inner member;

....moving the distal end portion of the inner member from a point inside the outer hollow cannula with the at least one mechanism to a position distal of the distal end of the outer hollow cannula

Again, it is respectfully urged that Silverman does not teach or suggest a mechanism, or moving an inner member with the mechanism to a position distal of the distal end of an outer cannula. Withdrawal of the rejection is requested.

103 Rejections:

Claim 20 is rejected as obvious over Silverman 2,198,319 as applied to Claim 17, and further in view of US 4,393,872 to Reznik et al. It is respectfully urged that this rejection is improper because it relies on the application of Silverman to Claim 17. As set forth above, Silverman does not teach a actuating a first mechanism or actuating a second mechanism. Accordingly, the obviousness rejection is improper because it based on a faulty premise that Silverman anticipates Claim 17.

Claims 21, and 22 are rejected as unpatentable over Schramm et al. '101' in view of Silverman. This rejection is improper for at least the following reasons.

It is respectfully urged that the Examiner has not met the burden of providing a prima facie case of obviousness. A prima facie case of obviousness requires that three basic criteria be met: 1. There must be some suggestion or motivation in the prior art to modify a reference or combine reference teachings; 2. There must be a reasonable expectation of success; and 3. The references when combined must teach or suggest all the claim limitations. (See MPEP 2143).

No Motivation to Combine:

As noted in the previous response, Schramm et al. '101 does not teach an inner member having a distal portion biased to expand radially at its distal end. Nor does Schramm et al. 101 teach or suggest an inner member distal portion that expands radially as the inner member moves distally relative to the outer member. Rather, Schramm et al. '101 teaches a first needle 86 and a second needle 96. Schramm et al. '101 further states that first needle 86 is a substantially solid shaft 87 with a tissue holding region 90 cut-out from shaft 87. (See Column 11, lines 50-62). It is respectfully urged that the substantially solid shaft 87 of Schramm et al. '101 does not teach or suggest expansion.

Nor does Schramm et al. '101 teach or suggest an inner member having a distal end portion that is closed radially by relative movement of the inner member and the outer member.

Further Schramm et al. '101' seems to teach away from the invention as claimed, as Schramm et al. '101' teaches that the inner needle is exposed at all times (see Schramm et al. '101' at column 12, lines 2-5 and lines 12-18 explaining the point of the inner needle is exposed at all substantial times of operation).

Because Schramm et al. '101' teaches an inner needle with a point that is exposed during operation, it is respectfully urged that one would not be motivated to combine Schramm et al. '101' with Silverman in the manner suggested by the Examiner. Instead, it is respectfully urged that the Examiner has improperly relied on the Applicants' teachings in hindsight in an effort to modify Silverman with the teaching's of Schramm et al. when Schramm et al. teaches away from the needle configuration sought by Silverman.

Combination would not teach the Claimed Method:

Further, it is not clear how the resulting combination would operate to provide the claimed method. For instance, as noted above, Schramm et al.'s apparatus is configured to have the distal point of the inner needle exposed at substantially all times of operation. So if one did take the spring device of Schramm et al. and place it in Silverman, it is respectfully urged that even if the resulting combination did operate, the resulting device would leave the inner needle of

Silverman substantially always exposed. In other words, even if one combined the references, it is not clear how the resulting combination would teach the claimed method.

It is respectfully urged that the Examiner is improperly engaging in hindsight reliance on Applicants' invention and improperly picking and choosing some features of Schramm et al, while ignoring others, in an effort to reconstruct the claimed invention.

Conclusion:

The Examiner is requested to reconsider the pending claims in light of the Remarks above, and to allow the claims in the next office action.

Respectfully submitted,


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